

REMARKS

Pursuant to 37 C.F.R. § 1.173(c), the applicant provides the following remarks for new claim 17. This new claim is based on the specification, claims, and drawings of U.S. Patent No. 5,897,307; no new matter has been added. The antecedent basis for claim 17 may be found in Figs. 2-5 and columns 4-6 of the issued patent.

With respect to the Office Action dated December 17, 2003. The Applicant herein presents arguments to traverse the Examiner's rejection of claims 1-15 based on a defective reissue declaration and based on an improper recapture of previously surrendered subject matter.

I. RESPONSE TO REJECTION BASED ON DEFECTIVE DECLARATION:

The Examiner has rejected claims 1-15 under 35 U.S.C. § 251 as being based upon a defective reissue declaration. The Examiner has stated that the reissue declaration "fails to identify at least one error being relied upon as the basis for the reissue." Applicant respectfully disagrees with the Examiner because the Applicant has in fact stated at least one error in the declaration.

The Examiner has stated that the "reissue declaration must identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid." This

standard put forth by the Examiner is based upon an incorrect interpretation of the MPEP. The MPEP states that "[i]n identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim." MPEP 1414 (emphasis added). The MPEP does not state that it is mandatory that the declaration identify a single word, phrase, or expression... only that it is sufficient. Therefore, other means of identifying at least one error must exist. One such method is laid out in MPEP §1402 which teaches that "[a]n attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue..." This is precisely what Applicant has done in paragraphs 1 and 2 of his declaration.

Paragraph 1 of the declaration states that "[i]nternal inconsistencies in the claims were inadvertently made when the claims were combined in original prosecution." Paragraph 2 of the declaration goes on to state that "the applicant brings this reissue application by reason of the patentee claiming less than he had the right to claim in the patent. The applicant has amended claim 1 and 10 and provided new claims 13-16 to broaden the claim language to better describe the invention as disclosed in Figs. 2-4 and in Columns 4 and 5 of the Patent Specification." Again, MPEP §1402 teaches that "[a]n attorney's

failure to appreciate the full scope of the invention was held to be an error correctable through reissue..." Accordingly, Applicant has, in fact, identified at least one error in that Applicant has declared that the patentee claimed less than he
5 had a right to claim. In other words, the former attorney failed to appreciate the full scope of the invention. This error is the basis upon which this reissue application is filed.

II. RESPONSE TO 35 U.S.C. § 251 REJECTION:

The Examiner has rejected claims 1-15 under 35 U.S.C. 251
10 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The Examiner has stated that the applicant previously surrendered during the prosecution of the application the following limitations: Claim 1: "intergrally
15 formed", "glossy", and "a width equal"; Claim 10: "glossy"; Claim 13: "integrally formed", "glossy", "a width equal". The Examiner further stated that "it is clear that when Applicant combined the subject matter of objected to claims to put them in condition for allowance, the applicant surrendered, in an effort
20 to obtain allowance, the original claims whether or not any statement limiting subject matter or arguments by applicant surrendering subject matter had been presented. In this regard see also Pannu v. Storz Instruments Inc., 59 USPQ2d 1597 (Fed.

Cir. 2001)." Applicant respectfully disagrees with the Examiner because the Applicant did not surrender the original claims.

MPEP §1412.02 demonstrates three situations where the recapture rule applies. The first and third examples are not applicable because the omitted limitations were neither originally argued, nor cited by the Examiner as a reasons for allowance. Examiner has recognized this and is therefore attempting to apply MPEP §1414.02 Example B (holding for the same proposition as Pannu) to the current situation. This application is incorrect.

Both MPEP §1412.02 and Pannu stand for the proposition that even when the applicant has made no argument regarding the omitted limitation, when "[t]he limitation omitted in the reissue was added in the original application claims for the purpose of making the claims allowable over a rejection or objection," then this too constitutes subject matter surrendered. MPEP §1412.02 (emphasis added). MPEP §1412.02 further elaborates by way of example whereby an original application with limitations A+B+C is rejected in an Office Action, and the applicant subsequently adds limitation D without explanation. This new limitation D constitutes subject matter that is surrendered. Similarly in Pannu, the applicant was "estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." In both of these

situations, the applicant actually added a new limitation in order to overcome an office action rejection. This is factually distinct from the situation here, where no new limitations were added to overcome the prior art rejection. The limitations were
5 already in the original application as dependent claims and were merely combined without any arguments put forth by Applicant, nor reasons for allowance stated by Examiner. No new limitations were added to overcome the prior art rejection. Accordingly, neither Example B from MPEP §1412.02 nor Pannu are
10 applicable, and the recapture rule does not apply.

As a matter of policy, this determination is warranted. The recapture rule was established to prevent applicants from regaining surrendered subject matter. In order to determine whether subject matter has been surrendered, direct evidence of
15 surrender can be determined through either an applicant's arguments or an examiner's reasons for allowance. Absent direct evidence of surrender, indirect evidence can be used in some circumstances. Such indirect evidence should only apply in the very limited circumstance where the applicant adds a new
20 limitation to avoid a rejection. In a case such as the instant case, where there is no applicant argument regarding the limitations, no reasons for allowance put forth by examiner, and no addition of a new limitation, then the recapture rule should not apply.

VI. CONCLUSION:

In light of the above arguments, the Applicant respectfully requests reconsideration of claims 1-15 and new claim 17. If any additional fees are required for this amendment and response, the Director is authorized to deduct the required amounts from our deposit account no. 500703.

Respectfully Submitted,

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By



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